

## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO. FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/720,952	01/03/2001	Rok Grahek	2260/106	8999	
7:	590 04/22/2003				
	mothy M Murphy omberg & Sunstein		EXAMINER		
125 Summer St	125 Summer Street		SHAMEEM,	SHAMEEM, GOLAM M	
Boston, MA 0	2110		ART UNIT	PAPER NUMBER	
			1626	6	
			DATE MAILED: 04/22/2003		

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/720,952	GRAHEK ET AL.
Office Action Summary	Examin r	Art Unit
The MALLING DATE COLL	Golam M M Shameem	1626
The MAILING DATE of this communication apperiod for Reply	pears on the cover sheet with th	correspond nce address
A SHORTENED STATUTORY PERIOD FOR REPL THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a replection of the period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a reply be y within the statutory minimum of thirty (30) o will apply and will expire SIX (6) MONTHS fro	timely filed  days will be considered timely.  Om the mailing date of this communication
Status		
1) Responsive to communication(s) filed on 10 F		
2a) ☐ This action is <b>FINAL</b> . 2b) ☐ Th	is action is non-final.	
3) Since this application is in condition for allowards closed in accordance with the practice under a Disposition of Claims	ance except for formal matters, Ex parte Quayle, 1935 C.D. 11,	prosecution as to the merits is 453 O.G. 213.
4) $\boxtimes$ Claim(s) <u>1-47</u> is/are pending in the application		
4a) Of the above claim(s) is/are withdraw	vn from consideration.	
5) Claim(s) is/are allowed.		
6)☐ Claim(s) is/are rejected.		
7) Claim(s) is/are objected to.		
8)⊠ Claim(s) <u>1-47</u> are subject to restriction and/or e Application Papers	lection requirement.	
9)☐ The specification is objected to by the Examiner.		
10) The drawing(s) filed on is/are: a) □ accept		amin or
Applicant may not request that any objection to the	drawing(s) he held in abeyance	200 27 CED 4 05(-)
11) The proposed drawing correction filed on	is: a) approved b) disappr	oved by the Evenines
If approved, corrected drawings are required in repl	y to this Office action.	oved by the Examiner.
12)☐ The oath or declaration is objected to by the Exa	miner.	
Priority under 35 U.S.C. §§ 119 and 120		
13) Acknowledgment is made of a claim for foreign	priority under 35 U.S.C. 8 119/2	al-(d) or (f)
a) ☐ All b) ☐ Some * c) ☐ None of:	7	2)-(a) or (i).
1. Certified copies of the priority documents	have been received	
2. Certified copies of the priority documents	havè been received in Applicati	ion No
Copies of the certified copies of the priorit application from the International Bure     See the attached detailed Office action for a list of	y documents have been receive	ed in this National Stage
14) Acknowledgment is made of a claim for domestic	priority under 35 U.S.C. & 119/6	e) (to a provisional application)
a) The translation of the foreign language provi  15) Acknowledgment is made of a claim for domestic  ttachment(s)	sional application has been re-	- to
Notice of References Cited (PTO-892)	🗖	
Notice of Neterlandes Cited (PTO-892)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5)   Notice of Information	(PTO-413) Paper No(s) Patent Application (PTO-152)
Patent and Trademark Office O-326 (Rev. 04-01) Office Actio	an Summan.	

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## **DETAILED ACTION**

This office action supersedes the previous office action of paper No. 7 which has been entered in the file.

## Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3 drawn to a process for preparing a HMG-CoA reductase inhibitor by a chromatography technique, classified in class 210, with several subclasses.
- II. Claims 4-25 drawn to another process for preparing a HMG-CoA reductase inhibitor by a chromatography technique, classified in class 210, with several subclasses.
- III. Claims 26-27 drawn to another process for preparing a HMG-CoA reductase inhibitor by a chromatography technique, classified in class 210, with several subclasses.
- IV. Claims 28-43 drawn to a HMG-CoA reductase inhibitor, classified in class 549, with several subclasses.
- V. Claims 44-47 drawn to another process for preparing a HMG-CoA reductase inhibitor by a chromatography technique, classified in class 210, with several subclasses.

The above Invention groups represent general areas wherein the Inventions are independent and distinct, each from the other because of the following reasons:

Invention groups I-III, V and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as

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claimed can be used to make other and materially different product or (2) that the product can be made by another materially different process (MPEP 806.05(f)). In the instant case, the process as claimed can be made at least one materially different process as demonstrated throughout the specification and Invention groups I-III and V, which are directed to several processes of preparing the product.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP 806.04, MPEP 808.01). In the instant case the different inventions are drawn to distinct processes of preparing compound of I-III and V requiring different search strategies because of the different reactive steps and conditions involved in each group.

Invention set I-III and V are distinct and independent from Invention IV because they are directed to different statutory classes of invention and, the practice of Invention I-III would not result in the practice of the other invention (group IV) and to search all the above groups in a single application would be an undue burden on the Examiner. Therefore a separate search considerations are involved, which would impose a burden if unrestricted. Also the fields of search are not coextensive. Additionally, besides performing a class/subclass search, the Examiner performs a commercial data base search and an automated patent system (text) search.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purpose as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for

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examination purposes as indicated is proper. Furthermore, the search required for any groups,

such as group I is not required for other group, such as group IV.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the

inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a petition under 37

CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an

election of the invention to be examined even though the requirement is traversed (37 CFR

1.143).

Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Golam Shameem, Ph.D. whose telephone number is 703-305-0116. The

Examiner can normally be reached on 8:30AM-5: 00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Joseph McKane can be reached on 703-308-4537. The fax phone numbers for the organization where this

application or proceeding is assigned are 703-308-7921 for regular communications and 703-308-7921

for after final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-308-1235.

Golam M M Shameem, Ph.D. Patent Examiner Art Unit 1626, Group 1620 Technology Center 1 alan L. Rotman

Supervisory Patent Examiner Art Unit 1625, Group 1620

Technology Center 1

April 18, 2003